

"Express Mail" mailing label number EV 655 031 255 US

Date of Deposit: January 12, 2006

PATENT  
CASE NO. 8285/288-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	)	
	)	
Bennett et al.	)	
	)	Examiner: H. Agdeppa
Serial No.: 09/293,266	)	
	)	Group Art Unit: 2642
Filed: April 16, 1999	)	
	)	
For: METHOD, SYSTEM AND	)	
ARTICLE FOR PLACING A	)	
TELEPHONE CALL TO A	)	
PREVIOUSLY-CALLED PARTY	)	

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reasons stated on the attached sheets. No more than five (5) pages are provided.

## **REMARKS**

In the final Office Action dated July 12, 2005, the Examiner rejected all of the pending claims as obvious under 35 U.S.C. § 103(a) as follows:

CLAIMS	COMBINED REFERENCES
1-4, 6, 8-11, 13-17, 19 and 20-28	Brandon (U.S. Patent 5,903,632) + Mirville et al. (U.S. Patent 5,745,553) + Tatchell et al. (U.S. Patent 6,160,877)
5, 7, 12, and 18	Brandon + Mirville et al. + Tatchell et al. + Levine (U.S. Patent 6,076,121)

### **I. The Rejections Under 35 U.S.C. § 103 (a) Fail to State a Prima Facie Case of Obviousness**

Applicants submit that the pending rejections fail to 1) cite references teaching or suggesting all of the claimed features; or 2) meet the requirement of adequately showing a teaching or suggestion to combine the cited references.

#### **A. Independent Claims 1, 8 and 14**

##### **1) Lack of suggestion/disclosure of all claimed features in cited art**

Claims 1, 8, and 14 recite, among other features: (i) storing a calling history for a calling party, where the calling history is generated using calling party identification information relating to the calling party; (ii) that calling party identification information relating to the calling party is received along with a dialed service code; and (iii) that a list of previously called parties is retrieved only upon receiving both the dialed service code and the calling party identification information. None of the cited references disclose these features.

Brandon may disclose a version of storing a log of outgoing telephone calls, but it does not disclose storing a calling history for a calling party, where the calling history is generated using calling party identification information relating to the calling party, as recited in Claims 1, 8, and 14. To the contrary, Brandon discloses a standalone device that is incorporated into a telephone and

that appears to store only those telephone numbers dialed using the specific standalone device. Thus, Brandon does not disclose storing a calling history that is generated using calling party identification information. Likewise, Brandon does not disclose receiving calling party identification information and retrieving a list of previously called parties only upon receiving both a dialed service code and the calling party identification information, as recited in Claims 1, 8, and 14. Again, Brandon discloses a standalone device that is incorporated into a telephone and that appears to store only those telephone numbers dialed using the specific standalone device. These stored numbers are accessed by using a page browser or keypad and pointer keys (Brandon, Col. 6, lines 1-7). Thus, these numbers can be accessed without the use of a dialed service code or calling party identification information.

With respect to Mirville et al. (disclosing on-demand network service options) and Tatchell et al. (disclosing methods of screening incoming calls), neither discloses storing a calling history for a calling party, so neither reference discloses storing a calling history that is generated using calling party identification information relating to the calling party. Likewise, neither Mirville et al. nor Tatchell et al. discloses retrieving a list of previously called parties only upon receiving both a dialed service code and calling party identification information. Accordingly, Claims 1, 8, and 14, as well as all related dependent claims, are patentable over the proposed combination for at least these reasons.

## 2) Lack of teaching or suggestion to combine

The cited references, in addition to lacking all of the claimed features, are not properly combinable. Brandon discloses a modified telephone that is self-contained and that can retrieve stored information (Brandon, Col. 2, lines 25-35). The self-contained, modified telephone is connected to the public telephone network but is not disposed within the public telephone network (Brandon, Col. 2, lines 36-39). Brandon makes clear that a principle objective of providing a self-

contained telephone directory system that includes all necessary components, including a central processing unit and databases (Brandon, Col. 1, line 38 - col. 2, line 8). The self-contained nature of Brandon is necessary to provide a faster and more cost efficient system architecture (Brandon, Col. 1, lines 42-49). Thus, the principle operation of the invention disclosed in Brandon requires that the automated telephone directory be implemented in a stand-alone telephone unit.

Despite this express disclosure in Brandon, the Examiner proposes to modify the teaching of Brandon such that functionality is removed from the telephone unit. This is contrary to Brandon's express teachings that functionality should be incorporated into the telephone unit to provide a faster and more cost efficient system architecture. Accordingly, the Examiner's proposed modification of Brandon is improper because it changes the principle of operation of Brandon (MPEP § 2143.01). The Examiner's proposed modification reintroduces the very same problem that Brandon sought to overcome. Moreover, Brandon teaches away from the Examiner's proposed modification in that it teaches that functionality should be incorporated into the telephone unit, not removed from the telephone unit, as the Examiner's proposed modification requires. The Examiner's proposed modification of Brandon is improper for this reason as well. Neither the incoming call screening features of Tatchell, nor the fee-based, user accessible call services announced to callers in Mirville et al. provide any teaching or suggestion to combine their features with those of Brandon – and, as noted above, the combination would still lack all of the claimed features.

B. Independent Claim 7

1) Lack of suggestion/disclosure of all claimed features in cited art

Claim 7 recites, among other features: (i) storing a calling history for a calling party, where the calling history is generated using calling party identification information relating to the calling party; (ii) that a personal identification number is received along with a vertical service code; and

(iii) that a list of previously called parties is retrieved only upon receiving both the vertical service code and the personal identification number. None of the references cited by the Examiner disclose these features.

Again, as noted above, Brandon discloses a standalone device that is incorporated into a telephone and that appears to store only those telephone numbers dialed using the specific standalone device. These stored numbers are accessed by using a page browser or keypad and pointer keys (Brandon, Col. 6, lines 1-7). Thus, these numbers can be accessed without the use of a vertical service code or a personal identification number.

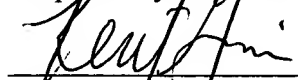
With respect to Mirville et al., Tatchell et al., and Levine, none of these references disclose storing a calling history for a calling party or the remainder of features recited above.

2) Lack of teaching or suggestion to combine

At least the same reasoning provided for claims 1, 8 and 14 above also applies to claim 7. The fourth reference, Levine, added to the combination also lacks any additional teaching or suggestion to combine the deficient disclosures sought to be combined.

The errors in the pending obviousness rejections are discussed with respect to the independent claims for purposes of brevity. The respective independent claims are submitted to be allowable for at least the same reasons. Applicants submit that this case is in condition for allowance.

Respectfully submitted,



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